

REMARKS AND RESPONSES

No claim is amended. Claims 1-17 remain pending in the present application. Reconsideration of the application in view of the following comments is respectfully requested.

Claim Rejection - 35 U.S.C. §103

The Office Action rejected claims 1-17 under 35 U.S.C. §103(a) as being unpatentable over Marmor et al. (US 2002/0062310 A1) in view of Harris (US 2002/0059204 A1), and further in view of Stefik et al. (US 5,629,980 A). Of the rejected claims, only claim 1 is independent.

The Office Action stated that Marmor discloses the limitation “uploading at least a first member account name of the copyright owner, the file fingerprint, the filename of the digital file, and a price to the copyright database for registration” and “uploading at least a second member account name of the file provider, the file fingerprints of the digital files, and the filenames of the digital files to the copyright database for comparing with the registered digital files provided by the copyright owner”. However, Marmor does not mention or suggest anything about file fingerprint.

In the present application, a file fingerprint is generated for each digital file. By comparing the file fingerprints with one another, it is ensured that every single digital file is unique and thus copyright of each digital file is automatically protected. A digital file (such as video or audio) can be very large, so generating file fingerprints is needed. In contrast, Marmor need not use any file fingerprint. In Marmor, the digital file for each product merely contains inventory and location information (paragraph [0010]), which is a small file, and thus does not need generating any fingerprints to distinguish one from another. Therefore, there is no motivation for one skilled in the art to use a file fingerprint in Marmor.

The Office Action stated that Stefik uses a Hash function. However, Stefik does not disclose the feature in claim 1 “uploading ...the file fingerprints of the digital files, ...for comparing with the registered digital files provided by the copyright owner”. Stefik

uses the Hash function merely to ensure that the transmission of the software content is secure and to ensure that the contents of the software, including the various scripts, before and after transmission, have not been tampered with (column 43, line 31-37). Stefik does not compare the fingerprints of different digital files to ensure that each digital file is unique. Additionally, the software, as stated in Stefik, is runnable software such as a new version of a player, which is different from the digital files described in the present application (column 42, line 50-55).

Since not all the limitations of claim 1 have been disclosed by the combination of Marmor, Harris, and Stefik, the present application should not be considered obvious.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). (MPEP §2143.03 All Claim Limitations Must Be Taught or Suggested)

Moreover, since there is no benefit for Marmor to use fingerprint files, there is no motivation for one skilled in the art to combine Marmor with Harris and Stefik.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, *absent some teaching, suggestion or incentive supporting* the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)

Since Marmor, Harris, and Stefik fail to teach, suggest, or otherwise render obvious the limitations of claim 1, the present application should be patentable over these references.

Of all the claims, only claim 1 is independent. Insofar as claims 2-17 depend from independent claim 1 and add further limitations thereto, the 35 U.S.C. §103(a) rejection of these claims should be withdrawn as well. Reconsideration and withdrawal of this rejection is respectfully requested. All claims in the present application are now

in condition for allowance. Early and favorable indication of allowance is courteously solicited.


Conclusion

For all of the above reasons, applicants submit that the specification and claims are now in proper form, and that the claims define patentably over prior arts. Therefore applicants respectfully request issuance for this case at the Office Action's earliest convenience.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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